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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/878,356	06/18/1997	ANTHONY PUMA		7005
7590	01/15/2004		EXAMINER	
HARVEY LUNENFELD 8 Patrician Dr. East Northport, NY 11731			HARRISON, JESSICA	
			ART UNIT	PAPER NUMBER
			3714	<i>14</i>
DATE MAILED: 01/15/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	08/878,356 Examiner Jessica J. Harrison	PUMA ET AL. Art Unit 3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 October 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 21,22 and 25-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 21,22 and 25-47 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Applicant's amendments of June 27, 2003 and October 16, 2003 are acknowledged. The end of the specification has been amended, claims 21, 22, 25, 30-33, 37 – 40 and 42 have been amended while claims 43 – 47 have been added.

Several issues illuminated in the prior office action remain outstanding. The relevant parts of the prior office action are repeated herein.

Priority

It is noted that applicant's preliminary amendment of 6/18/1997 altered the statement of the priority claim at the first line of the specification to state that the application was a continuation of 08/116249. (***Correction:** *this amendment altered page 21 of the disclosure and the section "Reference to Related Applications". At present, the priority claim reads "This application is a continuation of Serial No. 08/116,249 filed September 2, 1993, which is a continuation in part of application Serial No. 07/579,410 filed September , 1990."**). This statement is untrue as the instant application contains subject matter not present in the prior application as well as omitting reference to an intervening application. Applicant should review the claim for priority and correct as necessary. It is believed that the first sentence of the specification should read :

"This application is a continuation – in –part of application Serial No. 08/664,406 filed June 17, 1996, abandoned, which is a continuation of Serial

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No. 08/116,249 filed September 2, 1993, now US Patent 5.527.033, which is a continuation -in -part of application Serial No. 07/579,410 filed September , 1990, abandoned.”

Drawings/Appendix

This application contains drawings 1-23 (including alphas). At least drawings 19 – 23 are informal. It is requested applicant submit a complete set of formal drawings for review/approval.

It is also noted the instant application contains reference to attached appendices. These do not appear to be present in the file. Appendix listings of the type applicant submitted in the prior application may be submitted as part of the specification, or as drawings. It is requested applicant represent the appendices, either as additional pages to the end of the specification, or as additional drawings. Note that if presented as drawings, appropriate amendments to the specification will also be required.

Information Disclosure Statement

It is noted that a substantial amount of prior art is cited on applicant's prior patent 5,527,033. The examiner is in the process of obtaining the parent file for review of the art contained therein, as such art is considered pertinent to the instant application. If applicant has a copy of the prior PTO 1449 listing the US patents and particularly the non-patent literature, it is requested he submit it, addressed to the instant file, with the response to this office action.

This is for the convenience of the examiner to avoid the retying of all information on a new form. Copies of the information will be reviewed from the parent file; a listing if readily available is all that is being requested.

Further, applicant is requested to check the reference to Sobotka et al US patent 5,345,930 filed May 1, 1989 found on page 3 of the specification. There is no such corresponding patent to that inventor name. The patent referenced is of a different filing date and pertains to subject matter wholly unrelated to the instant application. Please provide the appropriate patent number if known, or delete the reference passage if not known.

Specification

A substitute specification including the claims is required pursuant to 37 CFR 1.125(a) because the number and nature of amendments, combined with the originally filed specification, render the instant file difficult for consideration and too confusing for processing or printing.

Specifically, it appears as though the originally filed specification contained underlining and bracketing in what appears to be an indication of amendments. For example, page 58, bridging lines 6 – 7 reads “timing chart for tow [man] player penalty time...”. On page 9, the reference paragraph to the appendixes appears entirely underlined. Page 15, line 13 reads “power play, [they are] it is charged...”.

Furthermore, substantial portions of specification (upwards of 30 pages) have been entered subsequent amendments, numbering at least 5.

Confusion further exists in that a substantial portion of amendment C'6(entered on page 64) is identical to the amendment C'4(entered on page 31). The specification should not duplicate itself.

Therefore, representation of the entire specification, including the pending claims, in appropriate form is necessary for consideration and processing. Note that any substitute specification should include/incorporate the referenced appendixes noted above and any appendixes submitted should be in a format consistent with current office practice. See MPEP 608.05.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendments under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and (c).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

It is noted that applicant has amended the specification to include support for the data being obtained from a simulated (hockey) game, or a video

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game. Applicant has pointed out support in the parent application, at least in claim 20. It was agreed that a video game was a reasonable interpretation of the language "simulated game" and as such did not comprise new matter. However, this amendment does not address all of the examiner's contentions.

Claims 30, 32, 37, 39, 42, 44, 45 and 46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection. More specifically, the examiner fails to find basis in the specification for the features set forth in these claims. No disclosure is seen setting forth the definition of the box scores, how or when they are obtained, or that the execution of the statistical conversion is accomplished in real time. Applicant should point out the specific page and line of specification where each of these claims is supported, or delete the new matter.

Claims 30, 32, 37, 39, 42, 44 and 46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As these claims recite subject matter not contained within the original specification as set forth above, the original specification fails to enable these claims as well.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21, 22, and 25 –47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At the onset, it is noted that applicant has amended the claims to be clearer in response to the previous rejections set forth by the examiner. However, the claims remain indefinite as explained hereinbelow.

Regarding claim 21, it is not clear how “accrued time and goals scored”, which appear to be data, in combination with a “calculating means for obtaining statistics from intermediate data” together comprise a means for converting scores to data which also comprise a device for obtaining data from a score. No clear relation can be drawn from the elements recited in the claims and structure disclosed in the specification. When attempting to “diagram” the claim, i.e. draw a picture of the listed elements in order to visualize that which would infringe the claim, no structure or “clear picture” can be rendered from the claim. It is not clear to what structure the “calculating means” refers. It could refer to the tape dispensing means generating timing charts. It could refer to the binary – to – digital converter or to the “planimeter” structure disclosed. Or, it could be referring to a database and calculator/computer means also disclosed. As the scope of the claim can not be reasonably surmised from the language used, even when viewed in light of the

specification, the claim is deemed vague and indefinite. Due to the indefiniteness, judgment can not be made as to the claims completeness. Applicant is reminded that all structure necessary for the invention to be operative should be recited in the claims.

Similarly, claims 25, 33 and 43 recite the same basic two elements with different/additional data recited. These claims have the same uncertainty as to precisely what is being defined.

In claim 22, it is not clear how the timer fits in with the recited accrued time and goals scored and the calculating means.

In claim 30, it is not clear how the rate at which the device operates further limits the structure of the device. This appears to relate the device's operational method.

In claims 32, 42 and 46, it is not clear how the time at which data is obtained further limits the structure of the device. This also appears to relate to the device's operational method.

With respect to claim 47, it defines a possibility that would provide for a duplicate of claim 26.

Finally, each of claims 32, 37, 38, 42, 44, 45 and 46 provide listings of possibilities and alternatives of all combinations and of such breadth that it is unclear if they actually further limit their parent claim. For example, claims 37 sets forth "at least one of (listing of 28 possibilities), with the last possibility being "and combination of at least two thereof". Claim 38 recites similar

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language. While the examiner is not a skilled claims draftsperson, applicant should consider using some similar generic language such as "wherein said at least one box score comprises any data obtained from a game"(dependent, of course, on a standard definition of a box score, or any supplied in applicant's specification).

Conclusion

It appears as though applicant's claims encompass allowable subject matter as the prior art fails to show or clearly suggest a converting device that converts box scores, through intermediate statistics, to final statistics of the type disclosed in the application. Applicant should more clearly define the invention in his claim language.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica J. Harrison whose telephone number is 703-308-2217. The examiner can normally be reached on 8 hour/M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

jjh
January 11, 2004



JESSICA HARRISON
PRIMARY EXAMINER